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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,856	07/28/2006	Shuya Kacchi	00862.110014.	9830
5514 7590 01/07/2011 FITZPATRICK CELLA HARPER & SCINTO 1290 Avenue of the Americas NEW YORK, NY 10104-3800			EXAMINER PICH, PONNOREAY	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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In re Application of: Kaechi)
Application No. 10/587856)
Attorney Docket No. 00862.110014)
Filed: July 28, 2006)
For: Method of Detecting and Authenticating)
Connection Target for Wireless)
Communication Apparatus)

**DECISION ON PETITION TO
WITHDRAW RESTRICTION
REQUIREMENT UNDER 37 CFR
§1.144**

This is a decision on the petition filed September 13, 2010 under 37 C.F.R. §1.144 and 37 C.F.R. §1.181 to withdraw an outstanding restriction requirement.

The petition is **Granted**.

RELEVANT PROSECUTION HISTORY

March 9, 2010	A restriction requirement of subcombinations useable together into 2 different groups was mailed out. Each subcombination was then held to have multiple patentably distinct species
April 09, 2010	A provisional election with traverse was made to Group 1 and Species 2a plus arguments were made about burden on the examiner not identifying one of the 3 reasons listed in the form paragraphs 8.01, 8.02 and 8.21 and that as this is an application filed under 35 USC 371 unity of invention practice must be followed and not 'normal US restriction practice'.
June 7, 2010	The restriction was repeated as the arguments were found not persuasive as a detailed explanation of burden was provided and that MPEP 1893.03(d) does not require only unity of invention to be used but rather is an additional requirement for applications filed under 371.
September 13, 2010	The petition was filed along with an amendment.
December 6, 2010	A quayle action was filed stating that previously withdrawn claims 5, 8, 13 and 16 were rejoined but claims 1, 3-4, 6-7, 9, 11-12, 14-15, and 17-18 still stood

withdrawn. Additionally, the letter stated applicant's traversal may no longer be relevant as applicant has since amended all the pending claims so they are no longer the same claims which were previously restricted. The letter then did not further elaborate any new grounds of restriction.

REGULATIONS AND PRACTICE

37 C.F.R. § 1.143 states:

If the applicant disagrees with the requirement for restriction, he may request reconsideration and withdrawal or modification of the requirement, giving the reasons therefor. (See § 1.111). In requesting reconsideration the applicant must indicate a provisional election of one invention for prosecution, which invention shall be the one elected in the event the requirement becomes final. The requirement for restriction will be reconsidered on such a request. If the requirement is repeated and made final, the examiner will at the same time act on the claims to the invention elected.

37 C.F.R. § 1.144 states:

After a final requirement for restriction, the applicant, in addition to making any reply due on the remainder of the action, may petition the Commissioner to review the requirement ... A petition will not be considered if reconsideration of the requirement was not requested (see § 1.181).

37 C.F.R. § 1.145 states:

If, after an office action on an application, the applicant presents claims directed to an invention distinct from and independent of the invention previously claimed, the applicant will be required to restrict the claims to the invention previously claimed if the amendment is entered, subject to reconsideration and review as provided in §§ 1.143 and 1.144.

37 C.F.R. § 1.181 states:

- (a) Petition may be taken to the Commissioner:
- (1) From any action or requirement of any examiner in the ex parte prosecution of an application, or in ex parte or inter partes prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;
 - (2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Commissioner; and
 - (3) To invoke the supervisory authority of the Commissioner in appropriate circumstances. For petitions in interferences, see § 1.644.

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declarations (and exhibits, if any) must accompany the petition.

(c) When a petition is taken from an action or requirement of an examiner in the ex parte prosecution of an application, or in the ex parte or inter partes prosecution of a reexamination proceeding, it may be required that there have been a proper request for reconsideration (§ 1.111) and a repeated action by the examiner. The examiner may be directed by the Commissioner to furnish a written statement, within a specified time, setting forth the reasons for his or her decision upon the matters averred in the petition, supplying a copy to the petitioner.

MPEP § 803 states:

Under the statute an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP § 806.04 - § 806.04(i)) or distinct (MPEP § 806.05 - § 806.05(i)).

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

CRITERIA FOR RESTRICTION BETWEEN PATENTABLY DISTINCT INVENTIONS

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP § 806.05 - § 806.05(i)); and

(B) There must be a serious burden on the examiner if restriction is required (see MPEP § 803.02, § 806.04(a) - § 806.04(i), § 808.01(a), and § 808.02).... For purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02....

MPEP § 1893.03(d) states:

Examiners are reminded that unity of invention (not restriction practice pursuant to 37 CFR 1.141 -1.146) is applicable in international applications (both Chapter I and II) and in national stage applications submitted under 35 U.S.C. 371..

DECISION

37 C.F.R. § 1.181(c) requires that an action by an examiner, to be properly petitionable, must be followed by a request for reconsideration, and a repeated action by the examiner.

In the above-identified application, applicant filed a request for reconsideration prior to the petition.

MPEP § 1893.03(d) sets forth that lack of unity practice is the proper avenue for separating inventions under 371 and not normal U.S restriction practice.

For the above reasons, the petition is **GRANTED**.

The restriction requirement is hereby **WITHDRAWN**.

The application will be forwarded to the examiner for consideration on the merits of claims 1-18.

/Tod Swann/

Tod Swann
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